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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,288	03/29/2000	Masao Okada	862.C1871	7078

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NEW YORK, NY 10112

EXAMINER

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/537,288

Applicant(s)

OKADA ET AL.

Examiner

John M Hotaling II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/18/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17, 19-28 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 19-28 and 32-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17,19-28 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attenberg US Patent 5,913,019 in view of Drake et al US Patent 5,487,010 and Frey et al US Patent 6,369,908. Attenberg discloses all of the instant application but does not specifically disclose the use of a virtual keyboard and specific memory devices or that a character string may be assigned to each logical layer. Specifically Attenberg discloses in Column 2 that the machine uses a touch screen to operate all functions from a displayed user friendly menu, a plurality of backgrounds, users may choose from among a menu of different computer generated, background or foreground images, multiple images on the same sheet that may be peeled off separately, that the user may modify the image, a composite image. Columns 3 and 4 disclose the use of a keypad, keyboard and a touchscreen. Columns 5 and 6 disclose that the stickers may have a variety of intended uses and that electronic processing techniques for generating first electronic image information from a projected image and for electronically incorporating a background image into the first electronic image information are well known in the art. Specifically this step includes the electronic incorporation into the image of the user of a background image selected by the user from among the multiple background images

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presented on the display. Column 6:16-21 disclose that techniques for electronically formatting and generating the electronic multiple information from the electronic single image information such that a printer will print out multiple images of the same image on a single sheet, are well known to those skilled in the art. Column 6:60-65 disclose that it is possible to eliminate the keypad and the functions performed by the keypad be installed in a touch screen. Column 7 discloses modifying the image and column 8 discloses a currency acceptor. With respect to a re-editing function this is seen as an obvious matter of choice well within the capabilities of one skilled in the art of program design. If one wants to have the user go back and edit each layer then the user could have the option to re-edit the layer. This would fall under the disclosure of column 5 lines 60-65 that electronic processing techniques for generating first electronic image information from a projected image and for electronically incorporating a background image into the first electronic image information are well known in the art and will not be further described herein. Column 8 also discloses that the composite image is made up of a plurality of layers and the multiple image file is generated from the saved captured images (layer 1 and layer 2 and a foreground image). This is an ordered layering system. Attenberg lacks in disclosing the use of a virtual keyboard used with a touch screen and specific memory devices. However, Attenberg discloses the use of a keyboard and that it is well known to place the functions of a keypad, which is a simplified version of a keyboard, onto a touch screen and that the composite image is stored in a memory device. In an analogous invention to Drake discloses a bumper sticker making apparatus which discloses that a touch screen and a keyboard are

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analogous input devices in column 1:45-51. Drake discloses allowing the user to present the user's own customized slogan. With respect to the specific types of stickers Attenberg and drake have the apparatus to print and layout any type of background, foreground and text. Drake also discloses in column 5 lines 35-65 the use of a motherboard and conventional memory means attached thereto. In an analogous invention to Frey therein is disclosed that it is an object of the invention to have a device which can create an electronic image of the user and to which the user can selectively add textual messages, audio data and other visual images. Column 4 lines 1-32 state that it is known to add a banner to the image as another graphical layer. Column 5 lines 57-63 discloses that the cpu uses standard software programs that are known in the art field to combine the electronic image captured by the camera, the optional superimposed banner, the optional audio message, and the optional text message into electronic files. Attenberg, Drake, and Frey are analogous inventions in that they are both related to sticker making kiosks. One of ordinary skill in the art would implement a virtual keyboard into the present machines given the motivation above that the functions of a keypad may be transferred to a touch screen and that a touch screen and a keyboard are analogous input devices for use in a sticker printing machine as disclosed by Attenberg. Additionally, one of ordinary skill in the art would understand the use of a plurality of types memory means for use in a computer environment the exact type of which would be an obvious choice well within the capabilities of one skilled in the art and selectable from a plurality of conventional memory devices and types. Specifically, with respect to the type of image file used, bit map, one of ordinary skill in the art would

understand that any file type that captures an image could be used. It would be obvious to one of ordinary skill in the art to implement a virtual keyboard in either of the references given the motivation that the sticker printing kiosks use touch screens.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**  
May 12, 2005

